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J 7709.18US03  
EXAMINER

BAYERL, R

E3M1/0316

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ART UNIT

PAPER NUMBER

2301  
DATE MAILED:

03/16/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined

Responsive to communication filed on 21 Jan 1994  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892. 2.  Notice re Patent Drawing, PTO-948.  
3.  Notice of Art Cited by Applicant, PTO-1449. 4.  Notice of Informal Patent Application, Form PTO-152.  
5.  Information on How to Effect Drawing Changes, PTO-1474. 6.

**Part II SUMMARY OF ACTION**

1.  Claims 45 - 59 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 1 - 44, 60 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 45, 47 - 55, 59 are rejected.

5.  Claims 46, 56 - 58 are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

**EXAMINER'S ACTION**

1. Statutory basis for the following rejection under 35 USC 103 has been given as paragraph 4 of the previous Office Action (paper #7, mailed 10 December 1993).

2. Claims 45, 47 - 55, 59 are rejected under 35 USC 103 as being unpatentable over Read Me First, CWC, Inc., June 1988, for the reasons given in paragraph 5 of the previous Office Action.

3. Claims 46, 56 - 58 are objected to for depending upon rejected claim 45, but would be submitted for Issue if placed in independent claim form. The reasons are those given in paragraph 6 of the previous Office Action.

4. Applicant's response to the Section 103 rejection, as made in the previous Office Action, is contained in the communications of 21 Jan 1994, which consist of an affidavit attempting to remove the Read Me First publication as a reference under 35 USC 102(b) and a request for reconsideration based upon the affidavit's sworn statement of the inventor, "President and co-founder" of the corporation which originated the manual, that although it bears a date of "6/88", a prima facie indication of a Section 102(b) publication, it was not made "available to the public, or to third parties not under a confidentiality agreement with CWC" [Examiner's emphasis] any earlier than 13 November 1988, one year before effective US Filing. The request for reconsideration further argues "that the Read Me First manuals were published by Applicant" and thus they do not qualify under 35 USC 102(a) as "acts of 'others'".

Initially, the Examiner notes that since the affidavit is being filed as a written declaration under 37 CFR 1.131, and thus is "required by any law, rule, or other regulation to be under oath" pursuant to 35 USC 25, it must contain the Statutory requirement of a warning to "the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 USC 1001)" (35 USC 25(b)). The affidavit is defective for lack of this warning.

Even were the requirements of 35 USC 25 to be met, however, the 21 Jan 1994 affidavit, while stating that the Read Me First manual was not made generally public prior to 13 November 1988, does not establish whether, under 35 USC 102(b), the "invention" set forth in that manual "was...in public use or on sale in this country more than one year prior to the date of the Application for Patent in the United States" [emphasis added]. Since the manual bears a "6-88" date, it appears that it was available before 13 November 1988 for certain users of the system it supports, such as "third parties" which were "under a confidentiality agreement".

MPEP 2125.03, in providing the Examiner guidance on this aspect of Statute, notes that "there is no requirement that 'on sale' activity be 'public'". Thus, if any manner of "on sale" activity regarding the invention of the manual took place prior to one year before the filing date in the United States, the Read Me First manual serves as evidence of a 35 USC 102(b)

statutory bar, even if it was not released to the public at large until a later date, and continues to form a valid basis of the rejection under 35 USC 103.

The affidavit further states that, to the inventor's knowledge and belief, "the invention set forth in the claims" was not "in public use or on sale in this country" "for more than one year prior to November 13, 1989" [again, Examiner's emphasis]. However, the rejection is under 35 USC 103, which is a requirement for non-obviousness as well as novelty. Even if no "on sale" activity of the "invention set forth in the claims" took place, an "invention" which renders "the claims" obvious might still have been sold before 13 November 1988.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

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STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM  
THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier  
communications from the Examiner should be directed to Raymond J.  
Bayerl, whose telephone number is (703) 305-9789. Any inquiry of  
a general nature or relating to the status of this Application  
should be directed to the Group receptionist, whose telephone  
number is (703) 305-9600.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2301

15 March 1994